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2.B.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/291,983 04/15/99 MARTIN

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EXAMINER

QM12/0117

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DEXTER, C

ART UNIT

PAPER NUMBER

3724

15

DATE MAILED:

01/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/291,983

Applicant(s)

Martin et al.

Examiner

Clark F. Dexter

Group Art Unit

3724



☒ Responsive to communication(s) filed on Nov 2, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-23 is/are pending in the application.

Of the above, claim(s) 10-15 and 17-22 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-9, 16, and 23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 14

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The amendment filed November 2, 2000 has been entered.

Inventorship

2. In view of the papers filed August 10, 1999, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by adding Gregory J. Erisoty as a second inventor for this application.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

Information Disclosure Statement

3. The information disclosure statement filed December 18, 2000 (paper #14) has been received and the references listed thereon have been considered.

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9, 16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over David in view of Wells, pn 679,653 (hereafter Wells '653).

David discloses a hacksaw with almost every structural limitation of the claimed invention but lacks the frame member having an arcuate portion extending substantially the entire length between the forward end portion and the maximum height portion. Wells '653 discloses a frame member with such an arcuate portion and teaches that the curved characteristic and the tubular characteristic combined provide a desired degree of elasticity along with the requisite strength to strain the saw blade for cutting. It is noted that the I-beam-shaped frame member of David is considered an equivalent strengthening characteristic of the frame member of David. Further, the Examiner takes Official notice that it is old and well known in the art, particularly the mechanical arts, that corners or sharp bends or the like create stress risers wherein stress is concentrated in a relatively small area of a component which may lead to premature failure of the component in that area. It is further known that to alleviate this problem, the material in that area must be either "overdesigned" (i.e., designed with stronger material or enough additional material to provide the needed extra strength and endurance for a sufficiently long life for the component) or designed

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more "efficiently" without such corners or curves to eliminate the stress concentration areas which usually provides benefits such as requiring less material resulting in a lighter weight component. Therefore, it would have been obvious to one having ordinary skill in the art to provide the frame member of David with the claimed arcuate portion for providing an efficient design along with the other well known benefits described above as well as those taught by Wells.

Further, the specifics of the arcuate portion as defined in the dependent claims would be the mere discovery of the optimum or workable ranges within the general conditions of the prior art by routine experimentation and therefore obvious to one having ordinary skill in the art.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-9, 16 and 23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claim of U.S. Patent No. Des. 403,224 to Martin et al. in view of Hepworth et al.

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Martin et al. discloses a hacksaw frame and lacks an elongated blade attached to the frame by a first mounting structure and a second mounting structure in the form of a tensioning device. However, to provide a blade and mounting structure to mount the blade onto the frame is inherent in the invention of Martin et al. since it is a hacksaw frame which is intended to be used with such structure. Further, to provide a tensioning structure as one of the mounting structures is old and well known in the art as evidenced by Hepworth et al. for facilitating removal and assembly of the blade onto the saw frame. Therefore, it would have been obvious to one having ordinary skill in the art to provide an elongated blade attached to the frame by a first mounting structure and a second mounting structure in the form of a tensioning device to perform the intended use of the frame and for the well known benefits including that described above.

Response to Arguments

8. Applicant's arguments filed November 2, 2000 have been fully considered but they are not persuasive.

In the paragraph bridging pages 4 and 5 of the amendment, applicant argues that "the use of the arcuate frame member has been combined with a frame member of I-beam construction to arrive at a frame member construction that handles blade tension loading in a manner superior to the constructions disclosed in either David or Wells '653." The Examiner does not disagree. However, the claims have not been rejected on David or Wells '653 each taken alone, but have been rejected on the combination of David in view or Wells '653.

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In the second paragraph on page 5 of the amendment, applicant argues that “[T]he invention of claim 1 is more than just taking the I-beam frame member of David and substituting the same into the arcuate frame member of Wells ‘653.” However, the Examiner respectfully submits that this is not the rejection that has been applied. The prior art rejection does not involve substituting the I-beam frame member of David into the arcuate frame member of Wells ‘653. Rather, the prior art rejection is that it would have been obvious to one having ordinary skill in the art to modify the I-beam frame member of David by replacing the relatively sharp bend (at the end adjacent 26) with an arcuate configuration as taught by Wells ‘653 for the reasons described in the prior art rejection. Further, the fact that the bending movement is distributed as tension in the upper end cap and as compression in the lower end cap is inherent due to their relative locations on the frame member and in fact occurs in David since tensioning the blade will pull leg members 25 and 26 toward each other causing tension in the upper end cap and compression in the lower end cap of frame 22.

In the paragraph bridging pages 5 and 6 of the amendment regarding claims 2-9, applicant argues that “the Examiner has failed to show by evidence that the subject matter of these dependent claims would be obvious. The Examiner respectfully disagrees with applicant’s statement as best understood. Many of the limitations of claims 2-9 are taught by David or the combination of David in view of Wells ‘653, and all are either taught or suggested by the combination, and applicants have not specifically indicated which limitations are not either taught or suggested by the prior art.

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In the paragraph bridging pages 6 and 7 of the amendment, applicant argues that the obvious double-patenting rejection is in essence improper because it involves a Design patent. The Examiner respectfully disagrees. The claim of the Design patent clearly includes the frame and the configuration thereof, and the claims of the present patent application are drawn in large part to the frame and its configuration. Because the claim of the Design patent and the claims of the present application are directed to the same subject matter, the obvious-type double-patenting rejection must be sustained. Applicant's attention is directed to MPEP 804, section IIB3 entitled "Design/Plant - Utility Situations."

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cfd
January 12, 2001